

## REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner rejects claims 14 and 15 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 14, the Examiner argues that the phrase “determining determines the subject tissue to be a diameter of blood vessels” to be nonsensical. Applicants respectfully disagree. The phrase “the determining” refers to the determining step in claim 13 from which claim 14 depends. The phrase after “the determining” further defines such step as “determines the subject tissue to be a diameter of blood vessels.” With regard to claim 15, the Examiner only argues that the same is vague without any specific objection thereto. Applicants assume that the Examiner objects to claim 15 for the same reasons as claim 14. Thus, similar to claim 14, the phrase “the determining” in claim 15 refers to the determining step in claim 13 and the language after such phrase further defines the determining step in claim 13. Thus, the determining determines the subject tissue based on a maximal current value flowing to the subject tissue and a time, up to a maximal current value. Thus, Applicants respectfully submit that claim 15 is also clear and definite. However, claim 15 has been amended to add a comma (,) after the word “time” to further clarify the claim to the Examiner.

Accordingly, it is respectfully requested that the rejection of claims 14 and 15 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In the Official Action, the Examiner rejects claims 13-16 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,033,399 to Gines (hereinafter “Gines”).

In response, Applicants respectfully traverse the Examiner's rejection under 35 U.S.C. § 102(b) for at least the reasons set forth below.

In the rejection, the Examiner merely compares Figures 2c and 3c of Gines to Figure 5 of the present application and argues that Gines discloses adaptive power feedback control and power cycling during blood vessel treatment.

Applicants respectfully submit that it is improper for the Examiner to refer to the Figures of Gines in rejecting claims 13-16. The Examiner has ignored the claim language and instead merely referred to Figures as support for rejecting the claims.

At best, Gines may disclose continuously measuring variable impedance and inducing multiple oscillations of the impedance by raising and lowering the RMS output power in response to the measured impedance.

However, there is no disclosure or suggestion in Gines of determining subject tissue based on a change of the high frequency power and setting output values and the number of times of the intermittent power based on the determined results, as is recited in independent claims 13 and 16. Thus, while Gines may, at best, disclose the "generating," "treating" and "converting" steps of claims 13 and 16, the "determining" and "setting" steps recited therein are simply not disclosed or suggested in Gines.

With regard to the rejection of claims 13-16 under 35 U.S.C. § 102(b), an electric surgery method having the features discussed above and as recited in independent claims 13 and 16, is nowhere disclosed in Gines. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of

the claimed invention, arranged as in the claim,"<sup>1</sup> independent claims 13 and 16 are not anticipated by Gines. Accordingly, independent claims 13 and 16 patentably distinguish over Gines and are allowable. Claims 14 and 15 being dependent upon claim 13 are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 13-16 under 35 U.S.C. § 102(b).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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<sup>1</sup> Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).